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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,802	12/07/2001	John R. Fredlund	83564SLP	8932

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EXAMINER
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GIBBS, HEATHER D

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/020,802	FREDLUND ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Heather D. Gibbs	2625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 and 26 is/are allowed.
- 6) ☒ Claim(s) 3-16, 18 and 27-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 09/08/06 has been fully considered but they are not persuasive. Upon further review and regarding claim 3, Os teaches an embodiment with a removable storage media. Applicant argues the removable storage media in Os stores scanner software, as opposed to digital image data. Col 5 Lines 47-58 teaches scanner software which determines if a document is present on the scan surface and generates raw scan data which is converted to a format supported by the target application and saved in a file format and mass storage location.

Considering claim 4, Applicant argues Han does not teach that the keyboard is not disclosed as being used for collecting information associated with the digital image. However, Col 2 Line 30-Col 3 Line 26 teaches of touch button panels that function to scan, copy, print, and fax the input image in to the input device.

Regarding claim 7, Applicant argues that Han and Brennan are not combinable because Brennan discloses a barcode scanner, as opposed to a document or image scanner in Han. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, a

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barcode scanner is combinable with a document or image scanner in that both devices are capable of reading images and like a flatbed scanner, it generally consist of a light source, a lens and photo conductor translating optical impulses into electrical ones.

Considering claim 8, Applicant argues that Irons teaches away from combination with Han. In Col 12 Lines 6-17, Irons teaches of software as applicant claims, which used the docket number/file image file name.

Regarding claim 10, Applicant states there in no motivation to combine Yamauchi's digital camera with Han's scanner. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both devices are reasonable alternatives to image processing as is well known in the art. Examiner would like to also point applicant's attention to Yamauchi Col 42 Lines 1-11, which teach the limitation that applicant argues.

For claim 27, Han teaches the purpose of the VGA monitor is to display images from the described embodiment. See Col 10 Lines 26-32.

Lastly, claim 28, Han teaches an 8-button navigational control panel 406 that is and can be used as the modification input. Examiner would like to point the applicant's

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attention to Col 11 Lines 42-48 and Col 12 Line 19-27, which teaches wherein the navigational button is used for cropping.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 4, 23,27-28,30 are rejected under 35 U.S.C. 102(e) as being anticipated by Han (US 6,608,707).

For claim 4, Han teaches a portable imaging system transportable by a user for scanning an image for later production of an image product, comprising: (a) first and second member movable between an open and closed position; (b) a scanning area disposed in either the first or second member and accessible when the system is in the open position for receiving and scanning the image to produced a digital image; (c) memory for storing the digital image; (d) a communication port adapted to transmit the digital image from the portable imaging system over a communications network to a device for later production of the image product from the digital image; and an input device adapted to collect information associated with the digital image, and wherein the

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input device is a keyboard or a touch screen display (Figs 1-2; Col 3 Lines 43-60; Col 11 Lines 11-15; Figs 6-12).

Regarding claim 23, Han discloses a second, redundant, memory to provide backup storage of the digital image to ensure the digital image is not lost (Col 10 Lines 1-11; Fig 3; References 52 or 58).

For claim 27, Han teaches a portable imaging system transportable by a user for scanning an image for later production of an image product, comprising: (a) a first and second member movable between an open and closed position; (b) a scanning area disposed in either the first or second member and accessible when the system is in the open position for receiving and scanning the image to produce a digital image; (c) a memory for storing the digital image; (d) a communication port adapted to transmit the digital image from the portable imaging system over a communications network to a device for later production of the image product from the digital image; and a video input device for receiving one or more video clip relating to the digital image (VGA monitor; Figs 1-2,4; Col 3 Lines 43-60; Col 6 Lines 15-20; Col 11 Lines 11-15,45-49).

Considering claim 28, Han discloses a portable imaging system transportable by a user for scanning an image for later production of an image product, comprising: (a) a first and second member movable between an open and closed position; (b) a scanning area disposed in either the first or second member and accessible when the system is in the open position for receiving and scanning the image to produce a digital image; (c) a memory for storing the digital image; (d) a communication port adapted to transmit the digital image from the portable imaging system over a communications network to a

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device for later production of the image product from the digital image; and a modification input for zooming, cropping, or rotating the digital image before or after storage in memory (8 button navigational control panel 406; Col 3 Lines 43-60; Col 6 Lines 15-20; Col 11 Lines 11-15,45-49).

Regarding claim 30, Han teaches An imaging system, comprising: a portable imaging device transportable by a user for scanning an image for later production of an image product, comprising: (a) a first and second member movable between an open and closed position; (b) a scanning area disposed in either the first or second member and accessible when the system is in the open position for receiving and scanning the image to produce a digital image; (c) a memory for storing the digital image; (d) a communication port adapted to transmit the digital image from the portable imaging system over a communications network to a device for later production of the image product from the digital image; and a printer communicably connected to the portable imaging device (Printer port 220 Figs 1-2; Col 3 Lines 43-60; Col 11 Lines 11-15; Figs 6-12) .

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Han '707 in view of Os (US 6,480,304).

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For claim 3, Han discloses a portable imaging system transportable by a user for scanning an image for later production of an image product, comprising: (a) first and second member movable between an open and closed position; (b) a scanning area disposed in either the first or second member and accessible when the system is in the open position for receiving and scanning the image to produced a digital image; (c) memory for storing the digital image; (d) a communication port adapted to transmit the digital image from the portable imaging system over a communications network to a device for later production of the image product from the digital image; (Figs 1-2; Col 3 Lines 43-60; Col 11 Lines 11-15).

Han does not disclose expressly an image input device having an opening for receiving a removable digital image media to enable digital image input at said opening from said digital image media to the memory of the portable imaging system.

Os discloses storing images from a portable media to a portable scanning device (Col 10 Lines 10-16).

Han & Os are combinable because they are from the same field of endeavor, imaging systems.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Os with Han to store information on any number of non-volatile memories.

The suggestion/motivation for doing so would have been to be accessible to any computer readable media.



Therefore, it would have been obvious to combine Os with Han to obtain the invention as specified in claim 3.

Regarding claim 22, Han discloses a second, redundant, memory to provide backup storage of the digital image to ensure the digital image is not lost (Col 10 Lines 1-11; Fig 3; References 52 or 58).

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hans '707 in view of Brennan (US 5,070,966).

Han discloses a portable imaging system transportable by a user for scanning an image for later production of an image product, comprising: (a) first and second member movable between an open and closed position; (b) a scanning area disposed in either the first or second member and accessible when the system is in the open position for receiving and scanning the image to produced a digital image; (c) memory for storing the digital image; (d) a communication port adapted to transmit the digital image from the portable imaging system over a communications network to a device for later production of the image product from the digital image; (Figs 1-2,4; Col 3 Lines 43-60; Coll 11 Liens 11-15).

Han does not disclose expressly a display disposed in either the first or second member for displaying the digital image and for displaying advertisement information when the system is in the open position.

Brennan discloses a scanner with a flat open for displaying of advertising or other information (Col 2 Lines 10-16).

Han & Brennan are combinable because they are from the same field of endeavor, scanners.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Brennan with Han to provide high visibility.

The suggestion/motivation for doing so would have been to provide a significant area of high traffic, as taught by Brennan.

Therefore, it would have been obvious to combine Brennan with Han to obtain the invention as specified in claim 7.

7. Claims 8,25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Han '707 in view of Irons (US 6,192,165).

For claim 8, Han discloses a portable imaging system transportable by a user for scanning an image for later production of an image product, comprising: (a) first and second member movable between an open and closed position; (b) a scanning area disposed in either the first or second member and accessible when the system is in the open position for receiving and scanning the image to produced a digital image; (c) memory for storing the digital image; (d) a communication port adapted to transmit the digital image from the portable imaging system over a communications network to a device for later production of the image product from the digital image (Figs 1-2; Col 3 Lines 43-60; Col 9 Lines 25-45; Col 12 Lines 6-8).

Han does not disclose expressly software for tracking information associated with the digital image; and software for tracking information associated with the digital image, wherein the information is an image name or a scanning date.

Irons discloses wherein scanned names within a scanner are located by users a software which uses the docket number/image file name (Col 15 Lines 36-53).

Han & Irons are combinable because they are from the same field of endeavor, an apparatus using digital images.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Irons with Han for such applications, such as digital filing.

The suggestion/motivation for doing so would have been to implement third party scanning to implement digital filing to decrease cost, as taught by Irons.

Therefore, it would have been obvious to combine Irons with Hans to obtain the invention as specified in claim 8.

For claim 25, Han discloses a second, redundant, memory to provide backup storage of the digital image to ensure the digital image is not lost (Col 10 Lines 1-11; Fig 3; References 52 or 58).

8. Claims 10,12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Han '707 in view of Yamauchi et al (US 6,020,982).

For claim 10, Han discloses a portable imaging system transportable by a user for scanning an image for later production of an image product, comprising: (a) first and second member movable between an open and closed position; (b) a scanning area disposed in either the first or second member and accessible when the system is in the open position for receiving and scanning the image to produced a digital image; (c) memory for storing the digital image; (d) a communication port adapted to transmit the digital image from the portable imaging system over a communications network to a

device for later production of the image product from the digital image (Col 6 Lines 15-20; Fig 9; Col 11 Lines 11-15).

Han does not disclose expressly an audio input device for receiving audio information relating to the digital image.

Yamauchi discloses an audio input device for receiving audio information relating to the digital image (Col 8 Lines 54-58).

Han & Yamauchi are combinable because they are from the same field of endeavor, imaging system.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Han with Yamauchi to incorporate a recording media.

The suggestion/motivation for doing so would have been from image playback.

Therefore, it would have been obvious to combine Han with Yamauchi to obtain the invention as specified in claim 10.

Regarding claim 12, Han discloses a second, redundant, memory to provide backup storage of the digital image to ensure the digital image is not lost (Col 10 Lines 1-11; Fig 3; References 52 or 58).

9. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Han '707 in view of Butikofer et al (US 6,574,443).

Han discloses a portable imaging system transportable by a user for scanning an image for later production of an image product, comprising: (a) first and second member movable between an open and closed position; (b) a scanning area disposed in either the first or second member and accessible when the system is in the open position for

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receiving and scanning the image to produced a digital image; (c) memory for storing the digital image; (d) a communication port adapted to transmit the digital image from the portable imaging system over a communications network to a device for later production of the image product from the digital image (Col 6 Lines 15-20; Fig 9; Col 11 Lines 11-15).

Han does not disclose expressly a kiosk community connectable to the portable imaging device wherein the kiosk comprises a computer and a printing device.

Butikofer discloses a kiosk community connectable to the portable imaging device wherein the kiosk comprises a computer and a printing device (Col 6 Lines 45-64).

Han & Butikofer are combinable because they are from the same field of endeavor, image production.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Butikofer with Han.

The suggestion/motivation for doing so would have been to provide a kiosk to produce customized images, as taught by Butikofer.

Therefore, it would have been obvious to combine Butikofer with Han to obtain the invention as specified in claim 29.

***Allowable Subject Matter***

10. Claims 17,26 are allowed.

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11. The following is a statement of reasons for the indication of allowable subject matter: Claims 17,26 are allowable over the prior art of record because the Examiner found neither prior art cited in its entirety, nor based on the prior art, found any motivation to combine any of the said prior art which teaches a modulated light source for illuminating the original image, said modulated light source functioning as a display when the portable image capture device is in the open position and also functioning as a light source for the scanning area when the portable image capture device is in the closed position, including all of the features recited therein.

### ***Conclusion***


12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather D. Gibbs whose telephone number is 571-272-7404. The examiner can normally be reached on M-Thu 8AM-7PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Heather D Gibbs  
Examiner  
Art Unit 2625

hdg



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JUL 11 2011  
UNIT 2625